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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kelli Hodge Kennedy et al. Examiner: Firmin Backer
Serial No.: 09/782,765 Group Art Unit: 3621
Filed: February 13, 2001 Docket No.: 10005680-1
Title: DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH CONSOLIDATED DOCUMENT
SERVICES MANAGEMENT

CERTIFICATE OF TRANSMISSION

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
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Sir:

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1. Transmittal of Reply Brief (1 pg.); and
2. Reply Brief to Examiner's Answer (7 pgs.).

Date: May 22, 2007

SAL: kmh

By: 
Name: Scott A. Lund (Reg. No. 41,166)9 Pages (including cover page)

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PATENT APPLICATION

ATTORNEY DOCKET NO. 10005680-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Kelli Hodge Kennedy et al.

Confirmation No.: 8873

Application No.: 09/782,765

Examiner: Firmin Backer

Filing Date: February 13, 2001

Group Art Unit: 3621

Title: DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH CONSOLIDATED DOCUMENT SERVICES
MANAGEMENT

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on March 22, 2007.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Respectfully submitted,

Kelli Hodge Kennedy et al.

By 

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Rev 10/05 (ReplyBrt)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Kelli Hodge Kennedy et al.	Examiner:	Firmin Backer
Serial No.:	09/782,765	Group Art Unit:	3621
Filed:	February 13, 2001	Docket:	10005680-1
Title:	DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH CONSOLIDATED DOCUMENT SERVICES MANAGEMENT		

REPLY BRIEF TO EXAMINER'S ANSWER

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

This Reply Brief is presented in response to the Examiner's Answer mailed March 22, 2007, and in support of the Reinstatement of Appeal / Notice of Appeal filed November 20, 2006 and the Appeal Brief filed December 12, 2006, appealing the rejection of claims 1, 3-7, 9, 10, 12-17, 19, 21, 23-27, 29, and 30 of the above-identified application as set forth in the Final Office Action mailed September 21, 2006.

At any time during the pendency of this application, please charge any fees required or credit any overpayment due to Deposit Account No. 08-2025 pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees required to Deposit Account No. 08-2025 under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Appellant respectfully requests reconsideration and reversal of the Examiner's rejection of pending claims 1, 3-7, 9, 10, 12-17, 19, 21, 23-27, 29, and 30.

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Reply Brief to Examiner's Answer
Appellant: Kelli Hodge Kennedy et al.
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Title: DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH CONSOLIDATED DOCUMENT SERVICES MANAGEMENT

ARGUMENT

Reply to Examiner's Response to Argument

Regarding the rejection of claims 1, 3-7, 9, 10, 12-17, 19, 21, 23-27, 29, and 30 under 35 U.S.C. 103(a) as being unpatentable over Straub et al. US Patent No. 6,216,141, in view of Ta et al. US Patent No. 6,931,545, Appellant notes that independent claim 1 is directed to a method of distributing a document of a user, and includes receiving a distribution request for the document from the user at the document distribution system controller and presenting the list of distribution options for the document to the user, wherein the user provides the document to the document distribution system controller, and the document distribution services include at least one of print services, electronic mail services, and print publishing services.

In addition, Appellant notes that independent claim 9 is directed to a computer-readable medium having computer-executable instructions for performing a method of distributing a document of a user, and includes receiving a distribution request for the document from the user and presenting the list of distribution options for the document to the user, wherein the user provides the document for distribution, and the document distribution services include at least one of print services, electronic mail services, and print publishing services.

In addition, Appellant notes that independent claim 10 is directed to a system for distributing a document of a user, and includes a user interface configured to present the list of distribution options for the document to the user, wherein the user provides the document to the system for distribution, and the document distribution services include at least one of print services, electronic mail services, and print publishing services.

In addition, Appellant notes that independent claim 19 is directed to a method of managing document distribution services of a plurality of document distribution providers, and includes presenting the document distribution services to a user having a document and receiving a distribution selection for the document from the user at the document distribution system controller, wherein the user provides the document to the document distribution system controller for distribution, and the document distribution services include at least one of print services, electronic mail services, and print publishing services.

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In addition, Appellant notes that independent claim 26 is directed to a computer-readable medium having computer-executable instructions for performing a method of managing document distribution services of a plurality of document distribution providers, and includes presenting the document distribution services to a user having a document and receiving a distribution selection for the document from the user, wherein the user provides the document for distribution, and the document distribution services include at least one of print services, electronic mail services, and print publishing services.

In addition, Appellant notes that independent claim 27 is directed to a system for managing document distribution services, wherein the document distribution system controller is adapted to present the document distribution services to a user having a document, and wherein the document distribution system controller is adapted to receive a distribution selection for the document from the user, wherein the user provides the document to the system for distribution, and the document distribution services include at least one of print services, electronic mail services, and print publishing services.

Independent claims 1, 9, 10, 19, 26, and 27, therefore, each recite that the user provides the document for distribution such that the user is presented with and/or makes a selection of distribution options for the document. In addition, independent claims 1, 9, 10, 19, 26, and 27 each recite that the document distribution services include at least one of print services, electronic mail services, and print publishing services.

Regarding independent claims 1, 9, 10, 19, 26, and 27, the Examiner asserts the following:

From Examiner perspective, a content distribution system usually comprises a distribution entity, a user entity and a content provider entity. Generally the content provider provides content to the system and the user request content from the system. In the Applicant claims there is only one entity that provide and request content to and from the distribution system. Therefore, when the entity/party requests content from the system, it acts as a user and when the same entity/party provides content to the distribution system, it acts like a provider. Therefore the user is the same as the provider providing content to the system (Examiner's Answer, pp. 5-6).

Contrary to the assertion of the Examiner, Appellant notes that "a user" as recited in independent claims 1, 9, 10, 19, 26, and 27 does not request content from the distribution

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system. Rather, "a user" as recited in independent claims 1, 9, 10, 19, 26, and 27 provides the document for distribution, while the document distribution providers provide document distribution services for the document. As such, "a user" as recited in independent claims 1, 9, 10, 19, 26, and 27 is presented with and/or makes a selection of distribution options for the document. Thus, "a user" as recited in independent claims 1, 9, 10, 19, 26, and 27 is the entity/party providing the document for distribution and is the entity/party presented with and/or making a selection of distribution options for the document.

In the Final Office Action mailed September 21, 2006, the Examiner recognized that "Straub et al. fail to teach wherein the user provides the content to the system for distribution" (Final Office Action mailed September 21, 2006; page 3). Accordingly, the Examiner contended that "Ta et al. teach a system/method wherein the user provides the content to the system for distribution" (Final Office Action mailed September 21, 2006; page 3). As such, the Examiner suggested that "it would have been obvious to one of ordinary skill in the art the time the invention was made to modify the invention of Straub et al to include Ta et al's system/method wherein the user provide the content to the system for distribution because this would have ensure that users' content is properly distributed" (Final Office Action mailed September 21, 2006; page 3).

In operation, the Ta et al. patent provides that "a content provider and distributor 300 provides digital content, such as a document, to a user system 400" (emphasis added) (col. 5, lines 29-31). As such, the Ta et al. patent provides that during the course of use, "the user 400 would request from the content provider 300 one or more documents, such as an electronic book, a multimedia file, a presentation, a form template, or the like" whereby upon receiving the request, "the content provider and distributor 300 could provide the requested content in protected form with a profile identification 10 to the end user 400" (emphasis added) (col. 5, lines 42-50).

Thus, with the system of the Ta et al. patent, the content provider 300 is the entity providing the content (i.e., one or more documents) while the user 400 is the entity requesting the content from the content provider 300. The user of the system of the Ta et al. patent (viz., user 400), however, is not the party providing the content nor is the user of the system of the Ta et al. patent (viz., user 400) presented with or select distribution options for the content. Rather, the content provider 300 of the system of the Ta et al. patent is the entity providing

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the content. The user of the system of the Ta et al. patent (viz., user 400), therefore, cannot be considered "a user" as recited in independent claims 1, 9, 10, 19, 26, and 27 because the user of the system of the Ta et al. patent is not the party providing the document. In addition, the user of the system of the Ta et al. patent (viz., user 400) cannot be considered "a user" as recited in independent claims 1, 9, 10, 19, 26, and 27 because the user of the system of the Ta et al. patent is not presented with nor do they make a selection of distribution options for the document. Accordingly, the user of the system of the Ta et al. patent does not constitute "a user" as recited in independent claims 1, 9, 10, 19, 26, and 27.

Although contrary to the roles defined within the system of the Ta et al. patent, the Examiner suggests the following:

...since the Ta et al patent provides that "a content provider and distributor 300 provides digital content, such as a document, to system 400", the content provider of Ta et al's system is a user of the system that provides content to the system (Examiner's Answer, p. 6).

Even if, arguendo, the content provider 300 of the Ta et al. patent is considered the user of the system of the Ta et al. patent, Appellant submits that the content provider 300 of the Ta et al. patent cannot be considered "a user" as recited in independent claims 1, 9, 10, 19, 26, and 27 because the content provider 300 of the Ta et al. patent is not presented with nor do they make a selection of distribution options for the document as recited in independent claims 1, 9, 10, 19, 26, and 27.

Furthermore, Appellant notes that the Straub et al. patent merely displays the document in the desktop window. The Straub et al. patent, however, does not provide document distribution services including at least one of print services, electronic mail services, and print publishing services for the document as recited in independent claims 1, 9, 10, 19, 26, and 27.

Accordingly, Appellant submits that modifying the Straub et al. patent in view of the Ta et al. patent, in the manner suggested by the Examiner, does not overcome the shortcomings of the Straub et al. patent and, therefore, does not teach or suggest all of the limitations of the present claims. Once again, Appellant notes that to establish *prima facie*

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obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Thus, for the reasons set forth above, as well as the reasons set forth in the Appeal Brief filed December 12, 2006, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claims 1, 9, 10, 19, 26, and 27, and submits that independent claims 1, 9, 10, 19, 26, and 27 are each patentably distinct from the Straub et al. and Ta et al. patents. As dependent claims 3-7 further define patentably distinct claim 1, dependent claims 12-17 further define patentably distinct claim 10, dependent claims 21 and 23-25 further define patentably distinct claim 19, and dependent claims 29 and 30 further define patentably distinct claim 27, Appellant submits that these dependent claims are also patentably distinct from the Straub et al. and Ta et al. patents. Appellant, therefore, respectfully submits that the rejection of claims 1, 3-7, 9, 10, 12-17, 19, 21, 23-27, 29, and 30 under 35 U.S.C. §103(a) is not correct and should be withdrawn, and that claims 1, 3-7, 9, 10, 12-17, 19, 21, 23-27, 29, and 30 should be allowed.

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Title: **DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH CONSOLIDATED DOCUMENT SERVICES MANAGEMENT****RECEIVED
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MAY 22 2007****CONCLUSION**

For the above reasons, Appellant respectfully submits that the art of record neither anticipates nor renders obvious the claimed invention. Thus, the claimed invention does patentably distinguish over the art of record. Appellant, therefore, respectfully submits that the above rejections are not correct and should be withdrawn, and respectfully requests that the Examiner be reversed and that all pending claims be allowed.

Any inquiry regarding this Reply Brief should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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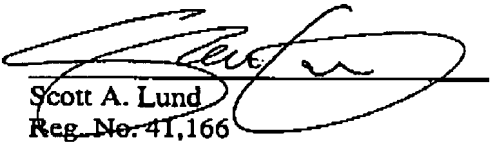
Respectfully submitted,

Kelli Hodge Kennedy et al.,

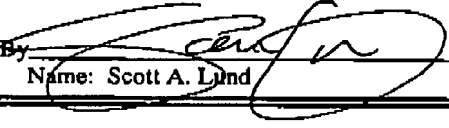
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 on this 22ND day of May, 2007.

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Name: Scott A. Lund